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TRANSCRIPT OF RECORD

Supreme Court of the United States

OCTOBER TERM, 1962

No. 322

ALEXANDER T. SPERRY, PETITIONER,

vs.

STATE OF FLORIDA, EX REL. THE FLORIDA BAR.

ON WRIT OF CERTIORARI TO THE SUPREME COURT
OF THE STATE OF FLORIDA

PETITION FOR CERTIORARI FILED AUGUST 10, 1962
CERTIORARI GRANTED OCTOBER 22, 1962

SUPREME COURT OF THE UNITED STATES

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[fol. 1] [File endorsement omitted]

IN THE SUPREME COURT OF THE STATE OF FLORIDA

STATE OF FLORIDA, ex rel., THE FLORIDA BAR, Petitioner,

vs.

ALEXANDER T. SPERRY, Respondent.

NOTICE OF INTENTION TO APPLY FOR PETITION FOR RULE TO SHOW CAUSE—Filed February 23, 1961

Please Take Notice that the Relator will apply to the Supreme Court of Florida on Monday, March 6, 1961, at 9:30 o'clock in the morning, or as soon thereafter as counsel can be heard upon the call of the motion calendar, for the issuance of Rule to Show Cause why Respondent Alexander T. Sperry should not be held in contempt of this Court for unauthorized practice of law and for an injunction in accordance with the prayers for Rule to Show Cause filed in the above styled original proceedings.

Sherwood Spencer, J. Lewis Hall, Donald J. Bradshaw, J. Nixon Daniel, Jr. and John H. Gunn, as and constituting the Special Committee of the Board of Governors of The Florida Bar on Patent Attorneys, Unauthorized Practice of Law.

Sherwood Spencer, of Counsel, 1909 Tyler Street, P. O. Box 6, Hollywood, Florida.

[fol. 2] Certificate of Service (omitted in printing).

[fol. 3]

IN THE SUPREME COURT OF THE STATE OF FLORIDA

STATE OF FLORIDA, ex rel., THE FLORIDA BAR, Petitioner,

vs.

ALEXANDER T. SPERRY, Respondent.

PETITION FOR RULE TO SHOW CAUSE—
Filed February 23, 1961

To the Honorable Justices of the Supreme Court of Florida:

[Handwritten notation—Grant—make rule returnable in 10 days—O'C, R, Drew, CT, ET]

The Florida Bar respectfully shows unto this Court as follows:

I.

That Respondent, Alexander T. Sperry, is engaged in the unauthorized practice of law, in that although he is not a member of The Florida Bar, he nevertheless maintains an office at the First National Bank Building, 8th Floor, in Tampa, Florida, and holds himself out to the public as a Patent Attorney, and with his knowledge and consent is so listed in the yellow pages of the current City of Tampa telephone directory, a copy of said listing being attached hereto, marked Exhibit "A", and made a part hereof.

The words "Patent Attorney" appear on the door entering the office of the Respondent at his aforesaid address, and the directory in the lobby of said First National Bank Building lists Respondent as "Patent Attorney" with his knowledge and consent.

[fol. 4] In addition to the foregoing acts of Respondent in which he holds himself out to the public as authorized to engage in the practice of law in the patent field, Petitioner is informed, and upon such information and belief alleges that Respondent represents Florida clients before

the United States Patent Office, and has rendered opinions as to patentability, and infringement opinions advising clients as to whether or not existing patents provide a basis for a cause of action in the Federal Court, and that Respondent has prepared various legal instruments, including contracts, applications and amendments to applications for letters patent, and filed same in the United States Patent Office in Washington, D. C., and has prepared briefs and authorities with points of law relating thereto.

II.

Section 2, Article II of the Integration Rule of The Florida Bar adopted by this Court provides:

> "2. No person shall engage in any way in the practice of law in this state unless such person is an active member of The Florida Bar, in good standing, except that a practicing attorney of another state, in good standing, who has professional business in a court of record of this state may, upon motion, be permitted to practice for the purpose of such business only, when it is made to appear that he has associated and appearing with him in such business an active member of The Florida Bar."

III.

That by reason of the matters and things heretofore alleged Respondent is holding himself out to practice in the patent field or phase of law without being a member of The Florida Bar and amenable to the Rules and Regula-[fol. 5] tions of the Florida Courts and Rules of Ethics heretofore adopted and promulgated by this Court, and contrary to the enunciations of this Court relating to the practice of law as outlined in the *Petition of Kearney*, 63 So. 2d 630.

IV.

That unless and until Respondent is enjoined by this Honorable Court from performing the acts hereinabove related, Petitioner is unable to properly protect the rights

of the lay public in various fields of law, including the law of patents.

V.

This proceeding has heretofore been authorized by the Board of Governors of The Florida Bar.

Wherefore, Petitioner Respectfully Prays:

1. That this Honorable Court issue its Rule to Show Cause directed to Respondent requiring him to appear and show cause before this Court why he should not be adjudged guilty of contempt for engaging in the unauthorized practice of law.

2. That under the power inherent in this Court, that this Court after a hearing on the matter issue its injunctive order permanently restraining Respondent from the acts herein complained of constituting unauthorized practice of law.

3. That Petitioner may have such further and other relief incident to this proceeding so as to protect Petitioner, the members of The Florida Bar, and the lay public, from the unauthorized invasion by Respondent into the practice of law.

The Florida Bar, By C. Clyde Atkins, President.

Sherwood Spencer, J. Lewis Hall, Donald J. Bradshaw, J. Nixon Daniel, Jr. and John H. Gunn, as and constituting the Special Committee of the Board of Governors of The Florida Bar on Patent Attorneys, Unauthorized Practice of Law.

Sherwood Spencer, Of Counsel.

[fol. 6] *Duly sworn to by C. Clyde Atkins, jurat omitted in printing.*

[fol. 7]

EXCERPT FROM EXHIBIT "A" TO PETITION

PATENT ATTORNEYS

Miller Gustave
501 13th st NW Washington D C
(Toll Chrg) Call Long Distance (Dial O)

Raney Roy E
Hall bl St Petersburg
(Toll Chrg) Call Long Distance (Dial O)

Sperry Alexander T 1st Natl Bank bl 2-3275

[fol. 30]

IN THE SUPREME COURT OF FLORIDA

January Term, A. D. 1961

[Title omitted]

ORDER DIRECTING RULE TO ISSUE—March 6, 1961

The petitioner in the above cause has filed a Petition for a Rule to Show Cause directed by respondent requiring him to appear and show cause before this Court why he should not be adjudged guilty of contempt for engaging in the unauthorized practice of law, and upon consideration thereof, it is ordered that the Rule issue.

[fol. 31]

IN THE SUPREME COURT OF FLORIDA

January Term, A. D. 1961

[Title omitted]

RULE TO SHOW CAUSE—March 6, 1961

In the Name and by the Authority of the State of Florida to Alexander T. Sperry, Greeting:

You are hereby required to show cause, if any you can, within ten (10) days from this date, why you should not be

adjudged in contempt of this Court for engaging in the unauthorized practice of law.

Witness the Honorable Elwyn Thomas, Chief Justice of the Supreme Court of Florida, and the Seal of said Court at Tallahassee, the Capital, on this 6th day of March, 1961.

....., Clerk of the Supreme Court of Florida.

[fol. 32] [File endorsement omitted]

IN THE SUPREME COURT OF THE STATE OF FLORIDA

[Title omitted]

ANSWER AND DEFENSES—Filed March 17, 1961

Now comes Alexander T. Sperry respondent in the above styled and numbered cause and files and serves herewith his answer and defenses to the petition for rule to show cause heretofore served upon him and says:

First Defense

For his first defense and answering the numbered paragraphs of the petition for rule to show cause the respondent says:

1. Answering the first unnumbered subparagraph of paragraph I the respondent denies that he is engaged in the unauthorized practice of law within the State of Florida, but admits that he is not a member of the Florida Bar. The respondent admits that he maintains an office in the First National Bank Building, 8th Floor, in Tampa, Hillsborough County, Florida, and says that he has held himself out to the public as a "Patent Attorney". The respondent admits that he has caused his name to appear under the classification of "Patent Attorney" in the telephone directory of the City of Tampa.

Answering the second unnumbered subparagraph of paragraph I the respondent admits that he caused the words

"Patent Attorney" to appear on his office door and on the [fol. 33] directory of the First National Bank Building in Tampa, Florida.

Further answering the first and second unnumbered subparagraphs of paragraph I respondent says that since the date of the filing of the petition for rule to show cause herein he has discontinued his use of the words "Patent Attorney" as a designation of the services he furnishes and now uses the word "Patents".

Answering the third unnumbered subparagraph of paragraph I the respondent admits that he represents Florida citizens before the United States Patent Office; he admits that he has rendered opinions as to patentability; and he admits he has prepared and filed before the United States Patent Office applications for patents and amendments thereto and patent assignments. Respondent admits that he has on one occasion advised a client as to whether an issued patent furnishes a basis of a cause of action for patent infringement, but says on that occasion the infringement opinion was part of his work in filing a patent application for the client. Respondent admits that he has formulated patent license agreements in rough form, but states that he has never prepared a finished patent license for execution by a client or for others to execute, respondent's activity being merely the preparation of a memorandum of the agreements of the proposed patent license. Respondent denies that he has prepared "various contracts" save for those herein admitted, and denies that he has prepared briefs and authorities with points of law relating thereto.

2. Respondent admits the allegations of paragraph II.

3. Respondent denies the allegations of paragraph III.

[fol. 34] 4. Respondent denies that the lay public will be protected by the issuance of the injunctive relief sought by the petition for rule to show cause as alleged in paragraph IV, but says, rather, that within his restricted field of practice before the United States Patent Office that he is able and competent to fully represent any citizen of the State of Florida as a member of the lay public before the

United States Patent Office and the application for and prosecution of patent applications, and in incidental work not solely related to the prosecution of patent applications.

5. The respondent admits the allegations of paragraph V.

Defenses

Further answering the petition for rule to show cause the respondent would state and show unto the Court that he began his work in the field of patents at the age of eighteen (18) years as a patent searcher. That on January 12, 1928 the respondent was admitted to practice before the United States Patent Office as a "Patent Attorney" being registration No. 12,529. That since that time the respondent has been continuously engaged in the profession of preparing patent and trademark applications and prosecuting matters relating to patents and trademarks before the United States Patent Office. That at the time of his admission in the United States Patent Office the sole nomenclature of that office for practitioners before it was that of "Patent Attorney" and that any person so admitted, whether an attorney licensed to practice law in any state or not was designated as "Patent Attorney". That thereafter, on November 19, 1938 the nomenclature of the Patent Office was changed to provide two designations: "Patent Attorney" for persons admitted before the Patent Office [fol. 35] who were licensed to practice before the bar of any state, and "Patent Agents" for practitioners who were licensed to practice before the United States Patent Office, but not licensed to practice before the bar of any state. It was specifically provided by the Patent Office that those who were originally admitted as "Patent Attorneys" should retain that designation. That the respondent has been continuously engaged in all aspects of processing applications before the United States Patent Office since the year 1925, including preparing and filing patent applications and amendments thereto, proceedings to make special, public use proceedings, interference proceedings and has likewise engaged in all phases of trademark practice before the United States Patent Office.

Adopting and repeating all and several the foregoing allegations and incorporating the same into each of the following affirmative defenses the respondent says:

Second Defense

For his second defense the respondent says that each and several the matters charged against him herein do not constitute the unauthorized practice of law under Section 2, Article II of the Integration Rule of the Florida Bar, or otherwise.

Third Defense

For his third defense the respondent says that the granting of the injunctive relief sought by the petitioner be inequitable, unfair and oppressive in that the granting of said relief would, in effect, deprive the respondent of the ability to earn a living in the preparation and prosecution of patent applications and the work normally incidental thereto within the State of Florida.

Fourth Defense

For his fourth defense the respondent says that the granting of injunctive relief against him herein would de- [fol. 36] prive him of property without due process of law under the Constitution of the State of Florida and under the Fifth and Fourteenth Amendments to the Constitution of the United States and that, further, the application of Section 2, Article II, of the Integration Rule of the Florida Bar to respondent in granting the relief sought by the petitioner would deprive him of property without due process of law under the Constitution of the State of Florida and of the Fifth and Fourteenth Amendment of the Constitution of the United States.

Fifth Defense

For his fifth defense the respondent says that the activity to which he is charged in the petition for rule to show cause, save for the preparation of brief and the general statement that he has prepared "contracts" are directly

similar to the activities engaged in by the so-called "Class B Practitioners" before various administrative tribunals of the Federal Government, including, but not limited to the National Labor Relations Board, Internal Revenue Service and the Interstate Commerce Commission. Such "Class B Practitioners" are not obligated to have legal training and on many occasions are not required to have the expertise in the field of speciality which the respondent has demonstrated by his admission to practice before the United States Patent Office.

Sixth Defense

For his sixth defense the respondent says that the work which he performs for Florida citizens is related solely to matters before the United States Patent Office, in the nature of the preparation and prosecution of patent applications and is not activity within the purview of Section 2, Article II of the Integration Rule of the Florida Bar.

[fol. 37] Seventh Defense

For his seventh defense the respondent says that the work performed by him for Florida citizens is solely that work which is presented to the United States Patent Office and that he charges fees solely for his work of preparing and prosecuting patent applications and patent assignments and determinations incident to preparing and prosecuting patent applications and assignments.

Respectfully submitted,

Harry Kemker, Attorney for Respondent.

Of Counsel: Fowler, White, Gillen, Humkey & Trenam; 1002 Citizens Building, Tampa 2, Florida.

Certificate of Service (omitted in printing).

[fol. 38]

IN THE SUPREME COURT OF THE STATE OF FLORIDA

[Title omitted]

MOTION FOR SUMMARY DECREE, OR IN THE ALTERNATIVE, MOTION FOR DECREE ON THE PLEADINGS (Oral Argument Wednesday, June 14, 1961, Five Man Court)

Comes now Petitioner, The Florida Bar, and respectfully shows unto this Court that the Respondent, Alexander T. Sperry, has heretofore filed his Answer and Defenses to the Petition charging him with unauthorized practice of law, and that said Respondent had admitted performing all of the acts which The Florida Bar alleges are acts of unauthorized practice of law except that he denies that he has prepared various contracts and denies that he has prepared briefs; accordingly, your Petitioner respectfully withdraws from the consideration of this Court the statements in its Petition charging Respondent with preparing contracts and briefs so as to enable the Court to have before it uncontradicted questions of fact.

Specifically, Respondent admits that he is not a member of The Florida Bar, and has committed the following acts:

1. That he maintained an office as a "Patent Attorney" in Tampa, Florida, and held himself out to the public as a "Patent Attorney", which activities he says he has dis- [fol. 39] continued since the filing of the Petition herein.

2. That he represents Florida clients before the United States Patent Office.

3. That he has on at least one occasion advised a client as to whether or not he had a cause of action for patent infringement.

4. That he has rendered opinions as to patentability.

5. That he has prepared and filed applications for letters patent.

6. That he has prepared and filed amendments to applications for letters patent.

That the facts alleged in the Petition which are admitted by Respondent's pleading show that there is no genuine issue of any material fact, and that Petitioner is entitled to a decree as a matter of law.

Wherefore, Your Petitioner respectfully moves this Court as follows:

1. To enter its Summary Decree herein granting the relief prayed for in the Petition of The Florida Bar, and enjoining Respondent from unauthorized practice of law.

2. In the alternative, Petitioner respectfully moves this Court to enter a Decree for Petitioner based upon the pleadings herein granting the relief prayed for in the Petition of The Florida Bar.

3. That this Court in and by its Decree define the practice of law in the State of Florida insofar as it relates to [fol. 40] the patent field or phase of law.

4. That this Court in and by its Decree specifically determine the activities which Respondent cannot perform in the patent field or phase of law in the State of Florida.

Sherwood Spencer, J. Lewis Hall, Donald J. Bradshaw, J. Nixon Daniel, Jr. and John H. Gunn, as and constituting the Special Committee of the Board of Governors of The Florida Bar on Patent Attorneys, Unauthorized Practice of Law.

By Sherwood Spencer, of Counsel.

Certificate of Service (omitted in printing).

[fol. 41] [File endorsement omitted]

IN THE SUPREME COURT OF THE STATE OF FLORIDA

[Title omitted]

REQUEST FOR ORAL ARGUMENT—Filed April 12, 1961

Comes now Petitioner in the above entitled cause, and requests an oral argument in said cause.

Sherwood Spencer, J. Lewis Hall, Donald J. Bradshaw, J. Nixon Daniel, Jr. and John H. Gunn, as and constituting the Special Committee of the Board of Governors of The Florida Bar on Patent Attorneys, Unauthorized Practice of Law.

By Sherwood Spencer, of Counsel.

Certificate of Service (omitted in printing).

[fol. 84]

IN THE SUPREME COURT OF FLORIDA

January Term, A. D. 1962

Not Final Until Time Expires to File Rehearing Petition and, If Filed, Determined.

Case No. 31,411

STATE OF FLORIDA, ex rel., THE FLORIDA BAR, Petitioner,

vs.

ALEXANDER T. SPERRY, Respondent.

OPINION—Filed April 4, 1962

Original Jurisdiction—Complaint from The Florida Bar.

Sherwood Spencer, J. Lewis Hall, Donald J. Bradshaw, J. Nixon Daniel, Jr., and John H. Gunn, as and constituting

the Special Committee of the Board of Governors of The Florida Bar on Patent Attorneys, Unauthorized Practice of Law, for The Florida Bar, Petitioner.

Harry Kemker, for Respondent.

O'CONNELL, J.

In this cause The Florida Bar, by petition filed in this Court, seeks to invoke the original jurisdiction of this Court asking that we require the respondent to show cause why he should not be held in contempt of this Court for the unauthorized practice of law, and further that we enjoin respondent from further unauthorized practice of law in this state.

Basically the petition alleges that the respondent, Alexander T. Sperry, is engaged in the unauthorized practice of law, in violation of Section 2, Article 4, Integration Rule, The Florida Bar, 31 F.S.A., in that although he is not a member of The Florida Bar, hereinafter referred to as the Bar, he nevertheless holds himself out to the public as a patent attorney, maintains an office in Tampa, Florida [fol. 85] on the door of which appear the words "Patent Attorney", and is so listed in the telephone directory of the City of Tampa and on the directory in the lobby of the building in which his office is located. Further, the petition alleges that the respondent represents Florida clients before the United States Patent Office, hereinafter referred to as Patent Office; has rendered opinions as to patentability and opinions as to whether or not patent rights are being infringed and are the subject of a cause of action in the courts; has prepared various legal instruments, including contracts, applications and amendments to applications for letters patent, and filed same in the Patent Office in Washington, D.C.; and has prepared briefs and authorities with points of law relating thereto.

Respondent filed an answer to this petition in which he admitted that he was not a member of the Bar, and admitted all the other allegations thereof with the exceptions or qualifications which follow.

As to advising clients on infringement of existing patents, respondent stated he did so only on one occasion

and that he did so as a part of his work in filing an application for a patent for a client. As to patent license agreements he alleged that he prepared such only in rough and never in finished form.

He denied that he had prepared any other contracts and denied that he had prepared briefs and authorities with points of law relating thereto.

In defense he also asserted, among other things, that he is duly admitted to practice before the Patent Office, having been admitted in 1928, and under the rules and regulations of that office he is authorized to use the nomenclature "Patent Attorney" even though he is not an attorney-at-law in any jurisdiction; the acts performed by him do not constitute the unauthorized practice of law; and that the injunctive relief prayed for would, if granted, deprive him of the ability to earn a living and deprive him of property without due process of law under the Constitution of [fol. 86] Florida and the Fifth and Fourteenth Amendments to the United States Constitution.

The matter has been submitted on the pleadings. The material facts being admitted there is no need for the taking of testimony.

While not raised by either party the first question which we feel necessary for decision is whether this matter is within the original jurisdiction of this Court.

In 1956 the electorate of this state adopted a revised Article V of our state constitution. Section 23 of this new article gives this Court "exclusive jurisdiction over the admission to the practice of law and the discipline of persons admitted."

Quite obviously this matter now before us does not involve either the admission of an applicant to the Bar or the discipline of one already admitted. The question then is whether the authority imposed in Section 23, Article V, also carries with it the power to prevent the practice of law by those who are not admitted to the practice. We think that it must and it does for if it does not the express power to control admissions would be meaningless.

This identical question was raised in a similar case in *West Virginia State Bar* v. *Earley*, W. Va. 1959, 109 S. E.

2d 420. We adopt as ours the words that court spoke in disposing of the question, at 109 S. E. 2d, p. 440, to-wit:

> ". . . It would indeed be an anomaly if the power of the courts to protect the public from the improper or unlawful practice of law were limited to licensed attorneys and did not extend or apply to incompetent and unqualified laymen and lay agencies. Such a limitation of the power of the courts would reduce the legal profession to an unskilled vocation, destroy the usefulness of licensed attorneys, as officers of the courts, and substantially impair and disrupt the orderly and effective administration of justice by the judicial department of the government; and this the law will [fol. 87] not recognize or permit."

The express power contained in our state constitution makes unnecessary any discussion of the inherent power of the courts to regulate the practice of law and those who engage in it. Were it necessary to do so there is abundant authority to support the view that the courts do have such power. *Petition of Florida State Bar Ass'n*, 1938, 134 Fla. 851, 186 So. 280; *Chicago Bar Ass'n* v. *Kellogg*, 1949, 338 Ill. App. 618, 88 N. E. 2d 519; *In re Baker*, 1951, 8 N. J. 321, 85 A. 2d 505; *West Virginia State Bar* v. *Earley*, 109 S. E. 2d 420, supra.

The next question then is whether this Court may enforce its authority in such matters by either or both contempt proceedings and injunction.

The unauthorized practice of law constitutes a contempt of court. *West Virginia State Bar* v. *Earley*, supra; *In re Baker*, supra. See also Cases Noted, 6 Miami Law Quarterly 606.

In *Hargett* v. *Lake*, Kent. App. 1957, 305 S. W. 2d 523, as in this case before us, a proceeding was brought originally in the appellate court seeking to have a person held in contempt and appropriately punished for practicing law without license or right. That court adjudged the person involved to be in contempt and ruled that " . . . he is permanently enjoined from engaging in the practice of law."

Aside and apart from these decisions which support the view that a court may invoke contempt and injunctive powers to enforce its authority in such matters, this Court has constitutional authority for so doing.

Sec. 4(2), Art. V, Fla. Const., F.S.A. gives this Court the authority to "issue all writs necessary or proper to the complete exercise of its jurisdiction." Having held above that the authority to regulate the practice of law by those not admitted to the Bar is vested in this Court under the cited section of the constitution, it follows that the power to issue writs necessary to enforce its rules [fol. 88] and orders applies to matters affecting the practice of law as much as to any other rule or order within its jurisdiction to enter.

The next question for decision is whether or not the acts committed by the respondent constitute the practice of law in this state. If this is answered in the negative our work is at an end. However if we find such acts to amount to the practice of law then we must determine whether, respondent having been licensed to practice before it by the Patent Office, this state has the power to deny the respondent the right to so practice in this state.

This Court has not previously been called upon to decide whether the activities charged against the respondent, i.e. the work done by a patent attorney, constitute the practice of law if done in this state.

In *Petition of Kearney,* Fla. 1953, 63 So. 2d 630, 631, this Court said that:

> "It follows that those who hold themselves out to practice in *any field or phase of law* must be members of the Florida Bar, amenable to the rules and regulations of Florida Courts. . . ." (Emphasis added.)

The Bar here urges that the practice of patent law is certainly a field or phase of law within the purview of this Court's opinion in the *Kearney* case.

There are however differences between the *Kearney* case and this one which require that we not treat it as dispositive of this case.

The petitioner Kearney was duly admitted to practice before the Supreme Court and the Tax Court of the United States and before the Treasury Department of the United States. He was not a member of The Florida Bar. He sought permission to practice in Florida as "Federal Tax Counsel" with his court appearances to be limited to the [fol. 89] federal courts and the departments above mentioned. This Court, in proceedings originating before it as in this case, ruled that the permission to practice in this state in the manner contemplated was not governed exclusively by the rules of the United States courts and departments; rather, it held that such would constitute the practice of law in this state and Kearney in order to do so would have to become a member of The Florida Bar, subject to the jurisdiction of this Court. In its opinion this Court cited Sec. 2, Integration Rule, supra, stressing that said rule provides that no person shall engage in any way in the practice of law in this state unless he is an active member of The Florida Bar.

In the *Kearney* case this Court obviously started with the premise that the activities which Kearney wished to pursue in this state constituted the practice of law. This Court did not discuss the question other than to state that the American Bar Association and many states hold that practice before the Tax Court and the Treasury Department may constitute the practice of law, citing decisions in support of the statement.

But in this case we cannot start with the premise that the activities of the respondent constitute the practice of law for he puts this question squarely in issue.

While the *Kearney* case may well stand for the proposition that practice before the Tax Court and the Treasury Department "may constitute the practice of law which may be enjoined if attempted by one not admitted to practice" (63 So. 2d at p. 630) it cannot be said to hold that practice before any or all other federal administrative agencies necessarily constitutes the practice of law.

[fol. 89a] The Bar refers us to certain decisions of courts of common pleas in Ohio which are directly in point and hold that activities such as those of the respondent here

do constitute the "practice of law." *Marshall* v. *New Inventors Club, Inc.*, 1953, 69 O.L.A. 578, 117 N. E. 2d 737; *Battelle Memmorial Institute* v. *Green*, 1961, 84 O.L.A. 353, 173 N. E. 2d 201. (See also *In re Battelle Memorial Institute*, Court of Common Pleas, Ohio 1960, 170 N. E. 2d 774 and 172 N. E. 2d 917.) These are not decisions of courts with final appellate jurisdiction and we do not accept them as binding precedent but we have found the reasoning expressed therein to be helpful to a fuller understanding of the problem under discussion.

[fol. 90] The Bar cites the case of *Chicago Bar Association* v. *Kellogg*, 88 N. E. 2d 519, supra. In that case the court held that the person so charged, without prejudice to his right to advise and assist applicants for patents in the presentation and prosecution of their applications for patents before the United States Patent Office, should be enjoined from the following activities:

1. giving legal advice;

2. preparing, drafting and construing legal documents, contracts, including patent licenses and deeds, assignments and other evidences of transfer of title to or interests in patent and other property;

3. rendering legal opinions, including legal opinions relating to title to, and validity, infringement and enforcement of, patents and trademarks and rights therein and thereto;

4. preparing, drafting and filing pleadings and other legal documents and papers in suits at law and in equity, in courts of record and before administrative tribunals, other than the Patent Office;

5. participating, as an attorney, in legal proceedings;

6. in behalf of persons represented by him, threatening to bring suits against other parties;

7. preparing and serving notice of and asserting attorney's lien; and

8. charging and collecting fees for legal services rendered by him and rendered by him and others.

[fol. 91] Apparently the court was not asked to and did not enjoin the preparation of applications for letters patent and of amendments to such applications. However, it did enjoin the charging of fees for legal services, including those wherein the Patent Office had jurisdiction.

Respondent's argument is that the practice of "patent law" is not the "practice of law." In support thereof he cites several cases which, while not actually in point, do strongly indicate the subject court's opinion to be that such practice is not the practice of law. *Zenith Radio Corp.* v. *Radio Corp. of America,* 121 F.Supp. 792 (D. Del. 1954); Application of Platamura, 1960, 22 Conn.Sup. 213, 166 A. 2d 859; *Public Service Traffic Bureau, Inc.* v. *Haworth Marble Co.,* 1931, 40 O.A. 255, 178 N.E. 703.

While few cases in other jurisdictions can be found relating to the question whether practice before the Patent Office constitutes practice of law, numerous decisions concerning such question as related to other agencies, departments and commissions can be found. There is lack of uniformity therein as to whether such practice is the practice of law. See Annotation 111 A.L.R. 19 (1937), supplemented in 125 A.L.R. 1173 and 151 A.L.R. 781.

The Patent Office, in the sense pertinent here, is an administrative agency, not a court.

Yet it is not the nature of the agency or body before which the acts are done, or even whether they are done before a tribunal of any sort or in the private office of an individual, that determines whether that which is done constitutes the practice of law. The best test, it seems to us, is what is done, not where, for the safest measure is the character of the acts themselves. If they constitute the practice of law the fact that they are done in the private office of the one who performs them or before a non-judicial body in no way changes their character.

Many courts have attempted to set forth a broad definition of the practice of law. Being of the view that such is nigh onto impossible and may injuriously affect the rights [fol. 92] of others not here involved, we will not attempt to do so here. Rather we will do so only to the extent required to settle the issues of this case.

It is generally understood that the performance of services in representing another before the courts is the practice of law. But the practice of law also includes the giving of legal advice and counsel to others as to their rights and obligations under the law and the preparation of legal instruments, including contracts, by which legal rights are either obtained, secured or given away, although such matters may not then or ever be the subject of proceedings in a court.

We think that in determining whether the giving of advice and counsel and the performance of services in legal matters for compensation constitute the practice of law it is safe to follow the rule that if the giving of such advice and performance of such services affect important rights of a person under the law, and if the reasonable protection of the rights and property of those advised and served requires that the persons giving such advice possess legal skill and a knowledge of the law greater than that possessed by the average citizen, then the giving of such advice and the performance of such services by one for another as a course of conduct constitute the practice of law.

We will use this measure in testing the acts of the respondent.

The first act to be performed by a person representing another who wishes to secure a patent on an alleged invention is to determine whether the device is patentable. As stated in *Marshall* v. *New Inventors Club, Inc.*, 117 N.E.2d 737, supra, at p. 739:

> "Not every alleged patent is patentable. Hence the rendering of an opinion as to patentability requires a knowledge of the patent statutes and of the decisions interpreting them. . . ."

A patent is undoubtedly a property right. It is difficult to see how any valid distinction can be made between [fol. 93] advising one as to whether he does or does not have a cause of action in a court involving his rights and advising one that he does or does not have a patentable device, under the laws and decisions applicable thereto, and the right to protect the invention by obtaining a patent.

The advising of persons as to their rights under the law universally has been held to be the practice of law. We think that one who holds himself out to the public in this state as qualified to advise as to patentability and does so is engaging in the practice of law. The same is true of the act of advising as to infringement of patent rights. Both require extensive knowledge of the law, statute and case, in a field of the law that is as technical and involved as any known today.

A patent is variously described as a public franchise or as a contract. In all definitions it is apparent that:

> "A patent duly issued amounts to a contract between the inventor and the government, under which the public, through the government, agrees that, in consideration of the inventor's disclosure of his invention and the grant of the right to use it after his patent expires, he shall be protected in his exclusive use during the life of the patent, . . ." 69 C.J.S., Patents, Sec. 5.

> "Patent is a contract by which the government secures to the patentee the exclusive right to vend and use his invention for a few years, in consideration of the fact that he has perfected and described it and has granted its use to the public forever after. The general rules for the interpretation of grants and contracts govern its construction. . . ." *National Hollow Brake-Beam Co.* v. *Interchangeable Brake-Beam Co.*, 106 Fed. 693 (8th Cir. 1901).

As pointed out by the Supreme Court of the United States in *Topliff* v. *Topliff*, 1892, 145 U.S. 156, 12 S.Ct. 825, 36 L.Ed. 658, the terms of those contractual documents which [fol. 94] constitute a patent make it one of the most difficult of all legal instruments to draw with accuracy. In speaking of the matter in that case the Supreme Court of the United States said, at 145 U.S., p. 171:

> ". . . The specification and claims of a patent, particularly if the invention be at all complicated, con-

stitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. . . ."

It is thus apparent that the preparation of applications for patents, and amendments thereto, involves the preparation of the terms of an involved contract and proof of the right to have same issued by the government, requiring legal knowledge and skill far in excess of that possessed by the layman. The preparation of such documents is unquestionably the practice of law and the fact that the preparation and procedures are not done in a court but rather before an administrative agency does not change the character of the acts from legal to non-legal.

Not only is the basic question of patentability controlled by law and court decisions but equally important is the fact that interpretations of the rights protected in a patent are made by the courts. Therefore in drafting and preparing the application and amendments he who prepares the documents must have a clear knowledge of the effect of the existing law on the questions involved, else valuable rights of the inventor may be forfeited.

It is also important to note that the application for a patent, the "actions" or objections thereto issued by the [fol. 95] examiner in the Patent Office, the "amendments" or answers filed to the "actions" by the applicant, and the final allowance or rejection by the examiner constitute the basis and subject matter of any appeal to a Board of Appeals of the Patent Office, and thereafter to the Court of Customs and Patent Appeals or to a federal district court, in the same manner that the record made in a trial court is the subject of review by an appellate court. In such a review of a decision of the Patent Office on a patent

application the review is limited to the matters presented in the application and amendments thereto, and if these documents do not adequately reflect and present the applicant's rights, as required by law and the decisions of the courts, valuable legal rights, which if properly presented to the Patent Office might be saved on review, will be lost.

All that is done in the proceedings before the Patent Office must therefore be done with the view that what is done will or may ultimately be interpreted as to meaning and measured as to sufficiency by a court or courts.

All of these considerations buttress our conclusion that the preparation of patent applications and amendments thereto by the respondent for others in a representative capacity does constitute the practice of law. This statement would also apply to the preparation of licensing agreements and other contracts involving patent rights and interests therein.

The remaining question then is whether the respondent, by virtue of his admission to practice before the Patent Office as a Patent Attorney, has the right to do these things in this state without being admitted to The Florida Bar.

We think this question was answered in the negative in the *Kearney* case, 63 So.2d 630, supra. As above noted, in that case we held that anyone who holds himself out to the practice "in any field or phase of law" must be a member of The Florida Bar.

[fol. 96] In other jurisdictions there seems to be a lack of accord on the question as it relates to practice before other administrative agencies of the federal government.

Respondent points out that in *Chicago Bar Association* v. *Kellogg*, 88 N.E.2d 519, supra, the appellate court in reversing the trial court on that issue refused to enjoin the patent attorney from preparing and prosecuting applications for patents, although it did enjoin him from preparing, drafting and construing "legal documents, contracts, including patent licenses and deeds, assignments and other evidences of transfer of title to or interests in patent and other property." 88 N.E.2d at p. 527. The court did not explain why it refused to enjoin the preparation of applications for patents and amendments thereto.

It did not state that it would not enjoin those acts because the respondent there was licensed by the Patent Office. On the contrary the court in its opinion, at 88 N.E.2d, p. 526, stated that:

"... The issue before us is not what things defendant may do under the authority he claims from his license to appear before the United States Patent Office, but what things, if any, he has done in violation of the laws of the State of Illinois...."

Just prior to making the above statement the court also said, at 88 N.E.2d, p. 526:

"... The courts of the State of Illinois, and not the United States Patent Office, may determine what constitutes the illegal practice of law in this State...."

It does not appear from the opinion that the court was asked to enjoin the preparation of application for patents and amendments thereto and this may be the reason why the court did not do so. No other reason is indicated in the opinion.

We do not think the opinion in that case supports this respondent's contention that the license to practice before [fol. 97] the Patent Office gives him the right to practice as a patent attorney in this state.

Respondent also cites the cases of *De Pass* v. *B. Harris Wool Co.*, 1940, 346 Mo. 1038, 144 S.W.2d 146, *Auerbacher* v. *Wood*, 1947, 139 N.J.E. 599, 53 A.2d 800; *In re Lyon*, 1938, 301 Mass. 30, 16 N.E.2d 74; and *Noble* v. *Hunt*, 1957, 95 Ga. 804, 99 S.E.2d 345. Each of these cases in some way supports the view that where a federal court or agency permits a layman to practice before it, a state may not prevent a layman who is licensed to practice before that court or board from such practice in the state even though such actions constitute the practice of law and practice of law by a layman is contrary to the policy of the state.

While we agree that each of the federal courts and each of those federal agencies which are authorized by Congress to do so may determine who shall be permitted to practice

before them, we do not agree that such authority in any way gives those bodies the authority also to determine that those licensed by it have the right to practice law, in the particular field involved, within the borders of this state.

It may well be that this state may not prohibit any person from appearing and practicing law before a federal court or agency in this state, if he be licensed by the federal court or agency, even though such person not be a member of the Bar of this state. But appearing before such bodies is an entirely different thing from a person holding himself out in this state as qualified to practice law before such federal bodies, maintaining an office in this state for that practice, and doing in this state the many things that are necessary to be done preparatory to the actual appearance before such bodies.

For example, if a United States Court of Appeals conducts sessions in this state attorneys from other states, not licensed to practice in this state, could not be prohibited from arguing before that court in this state, but they would not be permitted to establish an office and hold themselves out in this state as qualified to practice [fol. 98] before the federal court unless they were first admitted to the Bar of this state. The *Kearney* case, 63 So.2d 630, supra, settled this point directly.

If we were to hold otherwise any person licensed to practice before the United States Supreme Court or any other federal court could establish an office and hold himself out in this state as being qualified to represent Florida citizens before those courts without this state having any control over their right to so hold themselves out, or any control over their actions.

As a further example, if the federal district courts in this state were to license non-lawyers to practice before them, these non-lawyers, under the rule contended for by respondent, would have the right to establish an office in this state and to hold themselves out to the citizens of this state as qualified to practice law before such courts and this state would be powerless to protect its citizens in the matter.

Fortunately no such dispute has yet arisen between the states and the federal courts and it is hoped that it never will. Generally speaking the federal courts permit only duly admitted lawyers to practice before them and the matter of determining whether persons shall be admitted to the Bar has been left to the states. It appears that it is only in the federal quasi-judicial and administrative agencies, such as the Patent Office, that the non-lawyer is licensed to practice.

As above stated, we have no argument with the power of such agencies to determine who shall practice before them, but we do not agree that their licensing of a non-lawyer is in anywise to be taken as proof that the work done before them is not the practice of law or that one licensed by them has the right by virtue of said license to hold himself out as qualified to do those things in this state.

It is generally held that a state acting under its police power has the right to define the practice of law and to [fol. 99] determine who is qualified to practice within its borders. *Chicago Bar Association* v. *Kellogg*, 88 N.E.2d 519, supra; *Petition of Florida State Bar Association*, 186 So. 280, 285, supra; *Clark* v. *Austin*, 1937, 340 Mo. 467, 101 S.W.2d 977; *Richmond Association of Credit Men, Inc.* v. *Bar Association of City of Richmond*, 1937, 167 Va. 327, 189 S.E. 153.

We know of no provision in the Federal Constitution, or statutes for that matter, that gives to any federal body the power to determine who may practice law in the several states, or to define the practice of law within the states, and the respondent has cited us none. We do not think that the power to determine who may practice before it gives any such body the implied power to make either determination for this state.

We therefore hold that the license to practice before the Patent Office held by respondent does not give him the right to do in this state those things above listed.

The reason for prohibiting the practice of law by those who have not been examined and found qualified to practice is frequently misunderstood. It is not done to aid or pro-

tect the members of the legal profession either in creating or maintaining a monopoly or closed shop. It is done to protect the public from being advised and represented in legal matters by unqualified persons over whom the judicial department can exercise little, if any, control in the matter of infractions of the code of conduct which, in the public interest, lawyers are bound to observe.

It cannot be denied that the public suffers, as does both the public image of the legal profession and our judicial system, when those not qualified to do so are permitted to hold themselves out as qualified to practice law and as worthy of the trust and confidence of those who have legal problems the solution of which require trained advice and counsel.

If the truth be known the unauthorized practice of law by those not qualified and admitted actually creates work for the legal profession because of the errors and mistakes [fol. 100] of those who for others illegally perform legal work they are not competent to perform. In this the members of the legal profession gain, but the unfortunate members of the public who were ill-advised lose, in some instances quite badly.

It is the effort to reduce this loss by the members of the public that primarily justifies the control of admissions to the practice of law, discipline of those who are admitted, and the prohibition of the practice to those who have not proved their qualifications and been admitted. As incidents of this system the administration of justice is aided and the public image of the legal profession is enhanced.

Here it should be said that no one who evidences the reasonable standards of education, training, experience, good morals and character required by the rules of this Court and who can pass the bar examination, which is given twice yearly, is denied the privilege of practicing law in this state. There is no quota or limit to the number who may be admitted.

In fairness to the respondent in this cause we make clear that nothing we have said in this opinion is intended to indicate that he is not in fact competent to perform those services which he has rendered or that the affairs of any citizen of this state have suffered at his hands.

It may be that he is fully competent to practice law, that he has the educational and other qualifications required of an applicant for admission to the Bar of this state, and that he is well able to pass the bar examination, but until he has done so we have no way of assuring the public that he is qualified to practice law in this state.

Respondent argues that if we grant the injunction prayed for by the Bar we would deprive him of the ability to earn a living and deprive him of property without due process of law contrary to the guarantees of the Florida and United States Constitutions.

The issuance of an injunction by this Court will deprive respondent of the right to earn a living in the practice of [fol. 101] law in this state, but it will take nothing from him to which he has any right, for he does not now have the right to practice law in Florida. Nor will it in any way affect his right to practice before the Patent Office in Washington, D.C.

The right to practice law is not a privilege or immunity of a citizen of the United States within the meaning of the Fourteenth Amendment to the Constitution of the United States. *West Virginia State Bar* v. *Earley*, 109 S.E.2d 420, supra, *Ginsburg* v. *Kovrak*, 1958, 392 Pa. 143, 139 A.2d 889, appeal dismissed 358 U.S. 52, 79 S.Ct. 95, 3 L.Ed.2d 46. See also *Petition of Florida State Bar Association*, 186 So. 280, supra.

Our conclusion, then, is that the respondent, until and unless he becomes a member of the Bar of this state, should be and is permanently enjoined from the following activities in this state:

1. using the term "patent attorney" or holding himself out to be an attorney at law in this state in any field or phase of the law (we recognize that the respondent according to the record before us has already voluntarily ceased the use of the word "attorney");

2. rendering legal opinions, including opinions as to patentability or infringement on patent rights;

3. preparing, drafting and construing legal documents;

4. holding himself out, in this state, as qualified to prepare and prosecute applications for letters patent, and amendments thereto;

5. preparation and prosecution of applications for letters patent, and amendments thereto, in this state; and

6. otherwise engaging in the practice of law.

This injunction cannot and shall not in anywise be construed to affect any rights which the respondent has to practice before the Patent Office when done outside this state.

[fol. 102] It appearing to us that the respondent has cooperated in seeking a determination of his right to do the things charged against him and has not willfully violated any order or rule of this Court which clearly settled the issues involved here, we do not feel that we should now hold him in contempt of this Court. We have no reason to believe that he will not obey the injunction contained herein. If he does, then an order in contempt will be appropriate.

It is so ordered.

Roberts, C.J., Thomas, Drew and Thornal, JJ., concur.

[fol. 106]

IN THE SUPREME COURT OF THE STATE OF FLORIDA

[Title omitted]

PETITION FOR REHEARING

To the Honorable Justices of the Supreme Court of the State of Florida:

Comes Now the Respondent, Alexander T. Sperry, by and through his undersigned attorneys, and pursuant to Rule 3.14, Florida Appellate Rules, files this his Petition for Rehearing respectfully requesting this Honorable Court to reconsider its opinion and decision filed herein on April 4, 1962, enjoining the Respondent from certain activities enumerated therein, including the holding of himself out in this State as qualified to prepare and prosecute applications for letters patent, and the preparation and prosecution of applications for letters patent and amendments thereto before the United States Patent Office. As grounds for rehearing, he respectfully suggests the following:

1. At pages 6 and 7 of its opinion, the Court refers to certain decisions of the Court of Common Pleas of Ohio in the cases of *Battelle Memorial Institute* v. *Green*, 84 O.L.A. 353, 173 N.E.2d 201 (1961), and *In re Battelle Memorial Institute*, 170 N.E.2d 774, 172 N.E.2d 917 (1960). The Court states that it has "found the reasoning expressed therein to be helpful to a fuller understanding of the problem under discussion." On February 13, 1962, the Ohio Court of Appeals reversed the decisions in these cases and set aside the judgments of the Common Pleas Courts. That decision has not yet been reported in the West System, [fol. 107] but it is reported in 133 U.S.P.Q. at page 49. For the convenience of the Court, a copy of the opinion as it appears in 133 U.S.P.Q. 49, is attached hereto as Exhibit "A" to this Petition for Rehearing.

2. In holding that this Court has the absolute power to enjoin the Respondent from practicing before the United States Patent Office insofar as his activities are geographically sited in this state, the Court has overlooked the fact

that persons who are admitted to practice law in Florida are not thereby qualified or authorized to practice in patent matters before the United States Patent Office. This Court has therefore exercised control over that which it did not have the power to authorize in the first instance. Under Article 1, § 8, Clause 8, of the United States Constitution, matters relating to practice before the Patent Office are delegated to Congress. Congress has authorized the Commissioner of Patents to determine who is authorized to practice before the Patent Office. The control of practice before the United States Patent Office is a superior right vested exclusively by the Constitution and acts of Congress in the Commissioner of Patents; and Article VI, Clause 2, of the United States Constitution precludes any state from interfering therewith. A contrary result would enable the courts of the fifty states to nullify the acts of Congress and the Commissioner pursuant to Article I, § 8 of the Constitution.

3. In referring to Respondent's holding himself out as a "Patent Attorney", the Court overlooked the fact that since the Respondent was admitted to practice before the Patent Office in 1928, under its rules he is required to utilize the designation "Patent Attorney" rather than the designation "Patent Agent" which is available for those non-lawyers admitted to practice before the Patent Office after November 19, 1938.

4. To the extent that the Court implies that the Respondent has construed patent licenses or contracts or has done anything in the nature of the general practice of law in this [fol. 108] State, the Court has overlooked the fact that the Respondent has attempted to restrict himself exclusively to the representation of patent matters before the United States Patent Office and has not otherwise engaged in anything that could be considered the practice of law.

5. At pages 14 and 15 of this Court's opinion, it recognizes that it cannot prohibit out of state practitioners from appearing before federal courts or agencies in this state. The Court then distinguishes such appearance from an individual holding himself out in this state as qualified to practice before a federal court or agency. It is respectfully

submitted that there is no distinction between the two activities in as much as both constitute the practice of law. That is to say, if it is the practice of law in Florida to have an office in Tampa for the procurement of patent applications to go to the United States Patent Office in Washington, D. C., it is equally the practice of law in this state for an out of state lawyer not admitted to practice in this state to appear before a federal court in this state or to represent clients before an agency in this state. Indeed, appearance before a court or examiner is more clearly the practice of law than prosecution of patent applications.

6. In holding that this Court's injunction "will take nothing from him to which he has any right", at page 18 of its opinion, the Court overlooked the fact that it is depriving the Respondent of his right to appear before the United States Patent Office while a resident of the State of Florida. This right is in no way dependent upon him being admitted to practice law in the State of Florida; and this Court, in enjoining the Respondent from prosecuting applications to the United States Patent Office while geographically sited in the State of Florida, is infringing on his privileges and immunities as a citizen of these United States and is taking from him without due process of law his right to practice before the United States Patent Office [fol. 109] as recognized by the Commissioner of Patents. The cases cited at page 18 of this Court's opinion are not in point because they did not involve the impairment of rights derived exclusively from the Federal Constitution, statutes, and rules promulgated pursuant thereto by the courts of the states.

7. The Court's decision and opinion appears to establish for the first time in this state a rule that even though his activities are related to and coincide with other proper activities, no person can in any way participate in any activity which might include the rendering of legal advice or the preparation of legal documents without being a member of the Florida Bar. See 3 Fla. Jur., Attorneys at Law, § 7 (1955), and cases cited therein.

Wherefore, Respondent prays that rehearing be granted and that thereupon the opinion and decision of April 4,

1962, be withdrawn and the Respondent be granted leave to prepare and prosecute applications for letters patent and amendments thereto before the United States Patent Office.

Harry Kemker, Marvin E. Barkin, 1002 Citizens Building, Tampa 2, Florida.

By Marvin E. Barkin, Attorneys for Respondent.

Certificate of Service (omitted in printing).

[fol. 110]

EXHIBIT "A" TO PETITION FOR REHEARING

IN THE COURT OF APPEALS OF FRANKLIN COUNTY, OHIO

No. 6704

Battelle Memorial Institute,

Plaintiff-Appellant,

v.

Merritt W. Green, et al.,

Defendants-Appellees.

No. 6705

In the Matter of the Unauthorized Practice of Law in Franklin County,

In re: Battelle Memorial Institute,

Respondent-Appellant.

OPINION

Rendered on February 13, 1962

RUTHERFORD, J., of the Fifth Appellate District, sitting by designation.

Two separate appeals have been combined for hearing, we will consider both in this opinion.

The first is an appeal on questions of law from a judgment in case No. 197,718 in the Common Pleas Court of Franklin County, Ohio, and is here on appeal as case No. 6704. This case was brought by Battelle Memorial Institute v. Merritt W. Green and thirty other persons, being the duly appointed, authorized and acting members of the Unauthorized Practice of Law Committee of the Ohio State Bar Association and as representatives of Ohio lawyers so numerous that it is impractical to bring them all before the court. In this action Battelle Memorial Institute sought a declaratory judgment declaring that services performed by Battelle through members of its patent section do not constitute the unauthorized practice of law.

[fol. 110a] The second appeal is also on question of law, being from a judgment in case No. 196,819 in the Common Pleas Court of Franklin County, Ohio, and is here on appeal as case No. 6705. This case, which is captioned "In the Matter of the Unauthorized Practice of Law in Franklin County, Ohio; In re: Battelle Memorial Institute," was commenced upon application to the Court of Common Pleas of Franklin County, by a committee appointed by said court with instructions to make an inquiry and investigation as to whether persons, firms or corporations are engaged in the unauthorized practice of law in Franklin County.

The charge, as contained in the application, is that Battelle Memorial Institute, although not qualified to practice law and not admitted to the practice of law in Ohio, is nevertheless, engaged in the practice of law in Ohio; wherefore, it was prayed that the court issue an order restraining and enjoining said Battelle Memorial Institute from engaging in the practice of law.

In each case the opinion, as rendered by the Common Pleas Court, has been published. One opinion appears in 84 Ohio Law Abs., 161, and the other in 84 Ohio Law Abs., 353. Pertinent facts, as set forth by the Common Pleas Court, and as disclosed by the evidence, concerning the organization of Battelle are:

Battelle is a nonprofit corporation, organized to conduct scientific research for itself, for the United States Government, and for clients engaged in private industry, called "Sponsors." The complaint of unauthorized practice of law is limited to acts performed in connection with such "Sponsors," and solely to acts relating to patents.

Battelle has a staff of some 2,300 employees, about 1,200 of whom are scientists. It has some fifty divisions divided into seven departments. Its total business in 1959 was about $23,000,000.

[fol. 110b] The legal department of Battelle consists of seven members. Five members of this department are licensed to practice law in Ohio, and one is a lawyer admitted to practice in Colorado.

The legal department contains a patent section which specializes in the field of inventions and patents. Four men devote all their time to patent matters, and two devote about half of their time. Four members of the legal department (all attorneys) are registered in the U. S. Patent Office under the firm name of Gray, Mase and Dunson.

Because of the possibility that research of any kind might, and often does, include the possibility of a new invention and the obtaining of a new patent, every employee of Battelle, before being hired, is required to sign an agreement which obligates the employee to assign any and all inventions made by such employee to Battelle.

Every agreement with an industrial sponsor refers to Battelle's agreement with its employees, which requires them to assign their inventions to Battelle, and includes (in the agreement with such sponsor) a provision that if an invention is made during the course of the research on sponsor's project Battelle will notify the sponsor of this fact and permit the sponsor, at its election, to have such application and all rights to the invention assigned by Battelle to such sponsor. If the sponsor does not elect to exercise its option, Battelle remains the owner of the invention (after

assignment by the inventor) and would normally complete the patent. The patent section files and processes the application for a patent until such time as a sponsor elects to take an assignment thereof. In such event, the sponsor has the option of permitting Battelle to continue until the patent is obtained and actually assigned to the sponsor or of further processing the application with counsel of its own choosing.

The members of the legal department of Battelle are paid salaries by Battelle. By agreement with each sponsor, the expense of each project is paid by the sponsor. The time spent by each staff member of Battelle on each project, including scientists and members of the patent section, is kept and charged to the sponsor at a rate based upon the salary being paid to the persons performing the services.

The only tribunal in which members of the patent section work is the U. S. Patent Office. They appear in no courts of law, nor do they participate in any court proceedings.

[fol. 110c] The Common Pleas Court, in the declaratory judgment action, first found that a justiciable controversy did exist and then rendered judgment declaring as follows:

"(1) When salaried members of the legal department of patent sections of Battelle, who are employed to perform recognized legal services for Battelle in connection with applications for, or work in connection with, the obtaining of patents or inventions, cease to perform such legal services exclusively for Battelle and perform them for industrial sponsors of Battelle, this constitutes an unauthorized practice of the law.

(2) When salaried members of the Legal Department or Patent Section of Battelle perform legal services in connection with an application for, or work in connection with, the obtaining of a patent or invention after an industrial sponsor of Battelle has requested an assignment of any such patent or invention under the terms of the sponsor-Battelle contract, whether by execution of a formal written election or by any other

form of expressing its intent to acquire such patent or invention, they are no longer performing such legal services exclusively for Battelle but are in fact performing such legal services for such industrial sponsor, which constitutes an unauthorized practice of the law.

(3) From the evidence adduced at the hearing of this cause, the Court finds that certain of the salaried members of the Legal Department or Patent Section of Battelle have performed legal services in connection with applications for, or work in connection with the obtaining of patents or inventions after an industrial sponsor of Battelle has expressed its intent to seek an assignment of such patents and inventions under the terms of the sponsor-Battelle Contract, and that such legal services are for the industrial sponsors and constitute the unauthorized practice of law.

(4) The power to determine what persons may practice in the U. S. Patent Office is exclusively a power vested in Congress.

(5) A person is performing legal work when he performs such services as the drafting of contracts, applications for letters patent, amendments to applications for letters patent, affidavits and assignments, when he renders opinions as to the patentability, validity, infringement and interference in relation to inventions and patents, when he negotiates and drafts license agreements, and when he gives advice as to the rights and duties of persons and corporations and the fact that such services may be related to patents and inventions does not change the character of such services from legal services to non-legal services.

[fol. 110d] (6) The power to license persons to practice law is one of the police powers of each state.

(7) The power to admit a person to the practice of law is a judicial power and not a legislative power.

(8) The power to regulate, control and define the practice of law rests inherently in the judicial branch of the government.

(9) No agency of the federal government can dictate, define or limit the practice of law in Ohio.

(10) It is incorrect to say that all work performed in connection with the obtaining of a patent or invention is necessarily non-legal, or is necessarily not the practice law, simply because it is done under the rules and requirements of an administrative agency such as the Patent Office.

(11) The work done before an administrative agency may or may not constitute the practice of law, but if it does constitute the practice of law, and is done in Ohio, it must be done by persons who are duly licensed to practice law in Ohio.

(12) The State of Ohio has the right to say what constitutes the practice of law in Ohio, to prescribe the qualifications of those who may be allowed to practice law in Ohio, and to issue licenses to practice law in Ohio to those it finds are so qualified.

(13) The fact that under the rules of the Patent Office non-lawyers may be admitted to practice before such office does not in any way affect the determination by an Ohio court as to whether the performance of certain acts in the patenting of inventions constitutes the practice of law."

In the unauthorized practice of law action the Common Pleas Court made similar holdings to those declared in the declaratory judgment action and then rendered judgment permanently enjoining Battelle Memorial Institute, acting through its officers, agents, and/or employees from further engaging in the unauthorized practice of law as hereinbefore set forth, for industrial sponsors of Battelle.

Battelle Memorial Institute has appealed from the judgments upon questions of law in each case.

[fol. 110e] Several errors were assigned, a principal one in each case being that the trial court erred in failing to hold that the federal government has exclusive power and control over admissions to practice in the U. S. Patent Office, so as to preclude any state from interfering therein.

Cross assignments of error were filed in case No. 6704 on the ground that the trial court erred in overruling defendants' motion for a judgment of dismissal in the declaratory judgment action, at the conclusion of the evidence by refusing to conclude that there was no controversy ripe for decision, that there did not exist a justiciable issue, that the controversy therein could not be terminated, and that the petition and the evidence did not establish a cause of action.

The Constitution of the United States provides:

> Article I, Sec. 1. "All legislative powers herein granted shall be vested in a Congress of the United States, which shall consist of a Senate and House of Representatives."
>
> Sec. 8. "The Congress shall have the power to . . . promote the Progress of Science and Useful Arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries . . ."
>
> Article VI. "This Constitution and the Laws of the United States which shall be made in pursuance thereof, . . . shall be the supreme Law of the Land; and the judges in every State shall be bound thereby, anything in the Constitution or Laws of any State to the contrary notwithstanding."
>
> Amendment X. "The powers not delegated to the United States by the Constitution, nor prohibited by it to the states, are reserved to the states respectively, or the people."

Under the power specifically delegated to Congress by Article I, Sec. 8 of the United States Constitution, Congress enacted the provisions of Title 35 U.S.C.A. Sec. 31 and Sec. 32 in regard to Practice before the Patent Office.

> [fol. 110f] Title 35, Sec. 31. "The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the

Patent Office, and may require them before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office."

Title 35, Sec. 32. "The Commissioner may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent Office, any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 31 of this title, or who shall by word, circular, letter or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective business before the Office. The reasons for any such suspension or exclusion shall be duly recorded. The United States District Court for the District of Columbia, under such conditions and upon such proceedings as it by its rules determines, may review the action of the Commissioner upon the petition of the person so refused recognition or so suspended or excluded."

Title 35, Sec. 33. "Whoever, not being recognized to practice before the Patent Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense."

Title 35, Sec. 152. "Patents may be granted to the assignee of the inventor of record in the Patent Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title."

Under authorization from Congress the Commissioner of Patents has enacted rules governing practice before the Patent Office.

Rule 31. "Applicants may be represented by an attorney or agent. An applicant for patent may file and prosecute his own case, or he may be represented by an attorney or agent authorized to practice before the Patent Office in patent cases. . . ."

Rule 32. "Prosecution by assignee. The assignee of record of the entire interest in an application for patent is entitled to conduct the prosecution of the application to the exclusion of the inventor."

[fol. 110g] Rule 341 (c) "Requirements for registration. No person will be admitted to practice and registered (sic) unless he shall apply to the Commissioner of Patents in writing on a prescribed form supplied by the Commissioner and furnish all requested information and material; and shall establish to the satisfaction of the Commissioner that he is of good moral character and of good repute and possessed of the legal and scientific and technical qualifications necessary to enable him to render applicants for patents valuable service, and is otherwise competent to advise and assist them in the presentation and prosecution of their applications before the Patent Office. In order that the Commissioner may determine whether a person seeking to have his name placed upon either of the registers has the qualifications specified, satisfactory proof of good moral character and repute, and of sufficient basic training in scientific and technical matters must be submitted and an examination which is held from time to time must be taken and passed. The taking of an examination may be waived in the case of any person who has actively served for four years in the examining corps of the Patent Office."

Rule 348. "Suspension or disbarment proceedings. Except as otherwise provided, proceedings for suspension, disbarment, or exclusion from practice are before a Commissioner.

(a) Investigating and prosecuting officer. The duties of investigation, preparing charges, collecting and presenting testimony, and presenting a case for suspen-

sion, exclusion from practice or disbarment shall be performed by the Solicitor of the Patent Office or, at his direction, by a designated law examiner or other person, and neither the Solicitor nor such law examiner or other person shall participate in any manner in the decision of the case. If, upon investigation of a complaint or other information concerning an attorney or agent, it shall appear to the Solicitor that the grounds for suspension, exclusion from practice, or disbarment exist, he shall prepare and forward the necessary notice and statement."

The requirements for admission to practice before the United States Patent Office make it clear that skill in engineering and scientific matters and familiarity with patent procedures are as necessary as skill in legal matters, and persons who are not attorneys may qualify for admission as agents.

Normally, the practice of law is controlled exclusively by the judiciary. The reason why lawyers are officers of the court, and therefore subject to the control of the court is that they are admitted by order of the court. However, [fol. 110h] persons admitted to the practice of law by the Ohio courts are not thereby qualified or authorized to practice in patent matters before the U. S. Patent Office. This power has been reserved by the United States Constitution to Congress, and in turn by Congress it has been granted only to the Commissioner of Patents. This leaves the Ohio courts in the position of being unable to exercise control over that which they do not have the power to authorize in the first instance.

The case of The Land Title Abstract and Trust Co. v. Dworken, 129 Ohio St., 23, and other cases dealing with practice of law, as distinguished from practice before the United States Patent Office, are not relevant, not being cases in which a superior right has been retained in the federal government by the United States Constitution.

Were the courts of each state to control practice before the United States Patent Office, thus usurping a right to control that which they cannot authorize in the first instance, by considering it to constitute the practice of law

within their state; then the courts of the 50 states, by ignoring the provisions of Article VI of the United States Constitution, supra, could render the provisions of Congress in regard to practice before the Patent Office as enacted under the provisions of Article I, Section 8, of the United States Constitution, supra, a nullity.

It is our finding that the Commissioner of Patents, from the standpoint of unauthorized practice, has the exclusive right to determine whether the patent matters, in which Battelle participates through attorneys or agents employed by Battelle, are matters which constitute the business of Battelle due to a direct or primary interest of Battelle therein, or of Battelle by virtue of rights as an assignee as provided for under Title 35, Section 152, or Rule 32, supra, and whether Battelle is engaged in unauthorized practice [fol. 110] before the Patent Office.

For the reasons set forth, we conclude that control of practice before the U. S. Patent Office is a superior right vested exclusively by the United States Constitution and by acts of Congress in the Commissioner of Patents, subject to appeal to the federal courts, and the state courts, by virtue of Article VI of the United States Constitution, are bound thereby and preclude from interfering.

There is, however, a distinction to be made between the right of the federal government to control practice in patent matters and the right of a state to control acts of a corporation, incorporated under the laws of the state. The power to authorize persons to incorporate has not been delegated to the United States by the Constitution, nor prohibited by it to the states. Therefore, under the provisions of Amendment X of the United States Constitution, the right to provide for incorporation, and to determine what acts corporations shall be authorized to perform, is reserved to the states respectively. The state legislature, under authority as granted by their respective state constitutions, have the power to determine, by general laws, for what purposes corporations may be formed. The states could prohibit incorporation entirely within their respective limits should they see fit to do so.

Battelle Memorial Institute was incorporated in 1925, under the provisions of Section 10092-1, General Ohio (sic),

as a charitable trust not for profit as provided for in the Will of Gordon Battelle, deceased. At the time of incorporation in 1925, Section 8623, of the General Code, was in effect and provided:

> "Except for carrying on professional business, a corporation may be formed for any purpose for which natural persons lawfully may associate themselves."

[fol. 110j] A similar provision is contained today in Section 1701.03, of the Revised Code, which provides:

> "A corporation may be formed for any purpose or purposes, other than for carrying on the practice of any profession, for which natural persons lawfully may associate themselves. . . ."

It thus appears that the Ohio legislature, which does have the right to enact general laws under which corporations may be formed (Ohio Constitution, Art. 8, Sec. 2), has, by statute, precluded persons from incorporating for the purpose of carrying on "professional business" or "the practice of any profession." We will not discuss Section 1785.02, Revised Code, since it has no application to the facts of the instant cases.

Section 1701.04, Revised Code, now repealed, referred to in Battelle Memorial Institute's petition, would not be applicable in the instant cases. Section 8623, General Code, and Section 1704.03, Revised Code, have application to all corporations, but Section 1704.04, Revised Code, when in effect, was applicable only to corporations for profit, and would not include Battelle Memorial Institute, a corporation not for profit.

After consideration of this entire matter, we come to the conclusion that there are two ways of questioning the practices of Battelle, the first being to question whether Battelle is engaged in unauthorized practice in patent matters, as to which the exclusive right of control is vested by the United States Constitution in Congress, and, in turn, by act of Congress in the United States Patent Office; and the second being to question whether the acts of Battelle are ultra vires acts which are prohibited under the Ohio

statutes governing corporations, which statutes the Ohio legislature has power to enact and the Ohio courts have jurisdiction to enforce.

If the practices of Battelle, carried on through its agents or attorneys, in matters as to which the right of control has been reserved by the United States Constitution and [fol. 110k] Congress in the Commissioner of Patents, are to be questioned as being unauthorized practice in patent matters, the proceedings must be brought not before the Ohio courts but in the manner provided for by the acts of Congress passed under authority of Section 8, Article I, of the United States Constitution and Rules of the Patent Commissioner, authorized by acts of Congress, as hereinbefore set forth. This power in the federal government is exclusive and a superior right granted by the United States Constitution to Congress and, in turn, by Congress to the Commissioner of Patents, and the judges in every state are bound thereby.

If the acts of Battelle are to be questioned as being practices which are prohibited to Battelle as a corporation, by virtue of the Ohio statutes governing incorporation, then the action must be brought—

(a) In quo warranto as provided for under the provisions of Section 2733.01 et seq., Revised Code, which action can be commenced only in the Court of Appeals or the Supreme Court of Ohio in the manner as provided by said Section.

(b) By a proceeding to enjoin Battelle, as a corporation, from ultra vires practices in an action commenced by persons authorized to practice as agents or attorneys before the United States Patent Office, who have a vested interest to protect.

In the case of Abstract and Trust Co. v. Dworken, 129 Ohio St., 23, the Supreme Court of Ohio, in paragraph seven of the syllabus, held:

> "The right to practice law conferred by the state is a special privilege in the nature of a franchise and a possessor thereof may be protected by injunction from invasion of the right thus vested in him."

Practices before the United States Patent Office would not be an invasion of a right vested in an attorney by virtue [fol. 110 l] of his franchise to practice law in Ohio, since such franchise to practice law in Ohio does not authorize practice before the United States Patent Office in patent matters; but from the logic of paragraph seven of the foregoing syllabus, it would follow that the right to practice as an attorney or agent before the United States Patent Office, as granted by the Patent Commissioner, under act of Congress, may confer a special privilege in the nature of a franchise, the possessor of which may seek protection by injunction from the invasion of the right thus vested in him; such action to be brought in a federal court if the invasion to be enjoined is unauthorized practice before the patent office, or in the state court of the state of incorporation, if the act is to be enjoined not as unauthorized practice but as the commission of an ultra vires act by a corporation.

We point out the foregoing not to state what can or should be done or to here determine in advance the validity of such proceedings, since to do so would be obiter dicta; but to point out that neither of the instant cases can be considered as quo warranto proceedings because neither was brought in compliance with the Ohio statutes governing such proceedings; also, to point out that if an injunction is sought in Ohio courts it must not be on the ground of unauthorized practice of law, as such, but on the ground that the acts of the corporation are ultra vires and prohibited, and that an injunction proceeding cannot be commenced by attorneys franchised to practice only in Ohio; but must be commenced by agents or attorneys authorized to practice before the United States Patent Office, who are vested with a franchise right which is being invaded. In neither of the cases before us was there an allegation or evidence that all or any one of the members of the unauthorized practice of law committee against whom the declaratory judgment action was filed, or by whom the ap- [fol. 110m] plication in the unauthorized practice of law action was filed, are franchised to practice as either agents or attorneys in matters before the United States Patent Office.

If an action is brought in Ohio, either by quo warranto proceedings, or by agents or attorneys authorized to practice before the United States Patent Office seeking injunctive relief, the first question will be, whether as to the acts performed, Battelle has a direct or primary interest so as to authorize the performance of the acts by Battelle on its own behalf, as distinguished from acts performed for others. If it is determined that Battelle does not have a direct or primary interest in the acts performed, then the ultimate question will be: Not whether Battelle is engaged in "unauthorized practice of law," but whether Battelle is engaged in "professional business" or the "practice of a profession" within the meaning of Section 8623, General Code and Section 1701.03, Revised Code.

Neither of the cases herein appealed can meet the requirements of a proceeding in quo warranto, or of a proceeding for injunction commenced by a party having a vested interest alleged to be invaded. Neither case was so treated in the Common Pleas Court and, therefore, in neither case did the Common Pleas Court make any determination of the ultimate issue in such cases, to wit: Whether the practice complained of was an ultra vires act prohibited to the corporation, within the terms of the Ohio corporation statutes. The cases were filed and considered not under the Ohio statutes governing corporations, but solely from the standpoint of unauthorized practice of law in patent matters as to which the superior right is vested in the United States by the United States Constitution, by the provisions of which the courts of Ohio are bound.

It is our conclusion and finding that in case No. 197,718 in [fol. 110n] the Common Pleas Court of Franklin County, being case No. 6704 in this court, there was not a proper justiciable issue between proper and necessary parties. It will be ordered that the judgment of the Common Pleas Court be set aside and held for naught, and that the petition of Battelle Memorial Institute, appellant herein, be dismissed at costs of Battelle Memorial Institute.

In case No. 196,819, in the Common Pleas Court of Franklin County, being case No. 6705 in this court, the Common Pleas Court did not have jurisdiction by means of the issue raised and the judgment rendered to interfere with the

superior right granted to Congress by the United States Constitution. The action was not a proper one brought by proper and necessary parties and the judgment of the Common Pleas Court is ordered set aside and held for naught, and the application is ordered dismissed at costs of the members of the unauthorized practice committee who filed it.

In case No. 6704, judgment of the Common Pleas Court is set aside and petition dismissed.

In case No. 6705, judgment of the Common Pleas Court is set aside and application dismissed.

McLAUGHLIN, P. J., of the Fifth Appellate District, sitting by designation, concurs.

HILDEBRANT, J., of the First Appellate District, sitting by designation, dissents.

[fol. 111]

IN THE SUPREME COURT OF THE STATE OF FLORIDA

[Title omitted]

MOTION TO STAY ISSUANCE OF MANDATE

Comes Now the Respondent, Alexander T. Sperry, by and through his undersigned attorneys, and moves this Court, if it should deny the Respondent's Petition for Rehearing filed this date, pursuant to Rule 3.15, Florida Appellate Rules, and 28 U.S.C. § 2101(f), jointly and severally, to stay the issuance of the mandate in this cause and the effectiveness of its injunctive order for ninety (90) days conditioned upon this Respondent filing a petition for writ of certiorari or an appeal to the Supreme Court of the United States within that period of time; and says as grounds therefore the following:

1. Respondent submits that this case involves important questions of the interpretation of the United States Constitution with regard to the power of a state to restrict the right of an individual to practice before the United States Patent Office because that individual is geographically a resident of the state involved.

2. Within the ninety (90) days available to him under 28 U.S.C. § 2101 the Respondent intends to apply to the Supreme Court of the United States via petition for certiorari or appeal for a review of this Court's decision and opinion filed April 4, 1962.

3. This Court's opinion affirmatively shows that this Court recognizes that the Respondent has cooperated in seeking a determination of his rights and has not wilfully violated any order or rule of court.

[fol. 112] 4. Respondent's original attorney of record, Harry Kemker, Esq., is on vacation and out of this country.

5. The issuance of this Court's mandate and the effectiveness of its injunctive order will completely conclude the Respondent's ability to earn a living while a resident of the State of Florida and will work undue hardship upon him.

6. Respondent has over fifty (50) cases pending before the United States Patent Office, most of them for residents of Florida. If this Court's order is made immediately effective, his clients will be put to undue hardship in instantly having to obtain other representation. This Court has recognized Respondent's qualifications and if it should determine that he should be restrained from representing clients before the United States Patent Office, it will require a reasonable period of time for those clients to obtain other representation by persons entitled to practice before the Patent Office and to represent residents in this state. Due concern for the welfare of Respondent's clients requires a reasonable transition period.

Wherefore, Respondent prays that this Court stay the issuance of the mandate and the effectiveness of its injunctive order of April 4, 1962, for ninety (90) days conditioned upon the Respondent filing a petition for writ of certiorari or an appeal to the Supreme Court of the United States within that time.

Harry Kemker, Marvin E. Barkin, 1002 Citizens Building, Tampa 2, Florida.

By Marvin E. Barkin, Attorneys for Respondent.

Certificate of Service (omitted in printing).

[fol. 113]

IN THE SUPREME COURT OF FLORIDA

January Term, A. D. 1962

[Title omitted]

ORDER DENYING PETITION FOR REHEARING—May 15, 1962

The respondent in the above entitled cause has filed a petition for a rehearing and reconsideration of the Court's opinion and decision in the cause filed April 4, 1962, and since the filing of said opinion and decision, the Court has stricken the paragraph beginning at the bottom of page 6 of the original opinion and of the opinion as mimeographed in this office, which paragraph extends to the top of page 7 of said opinion and copy thereof.

The petition for rehearing has been addressed to the opinion as above revised and is denied.

[fol. 114]

IN THE SUPREME COURT OF FLORIDA

January Term, A. D. 1962

Corrected Copy

Not Final Until Time Expires to File Rehearing Petition and, If Filed, Determined.

Case No. 31,411

STATE OF FLORIDA, ex rel., THE FLORIDA BAR, Petitioner,

vs.

ALEXANDER T. SPERRY, Respondent.

OPINION AS MODIFIED—Filed April 4, 1962

Original Jurisdiction—Complaint from The Florida Bar.

Sherwood Spencer, J. Lewis Hall, Donald J. Bradshaw, J. Nixon Daniel, Jr., and John H. Gunn, as and constituting

the Special Committee of the Board of Governors of The Florida Bar on Patent Attorneys, Unauthorized Practice of Law, for The Florida Bar, Petitioner.

Harry Kemker, for Respondent.

O'Connell, J.

In this cause The Florida Bar, by petition filed in this Court, seeks to invoke the original jurisdiction of this Court asking that we require the respondent to show cause why he should not be held in contempt of this Court for the unauthorized practice of law, and further that we enjoin respondent from further unauthorized practice of law in this state.

Basically the petition alleges that the respondent, Alexander T. Sperry, is engaged in the unauthorized practice of law, in violation of Section 2, Article 4, Integration Rule, The Florida Bar, 31 F.S.A., in that although he is not a member of The Florida Bar, hereinafter referred to as the Bar, he nevertheless holds himself out to the public as a patent attorney, maintains an office in Tampa, Florida [fol. 115] on the door of which appear the words "Patent Attorney", and is so listed in the telephone directory of the City of Tampa and on the directory in the lobby of the building in which his office is located. Further, the petition alleges that the respondent represents Florida clients before the United States Patent Office, hereinafter referred to as Patent Office; has rendered opinions as to patentability and opinions as to whether or not patent rights are being infringed and are the subject of a cause of action in the courts; has prepared various legal instruments, including contracts, applications and amendments to applications for letters patent, and filed same in the Patent Office in Washington, D.C.; and has prepared briefs and authorities with points of law relating thereto.

Respondent filed an answer to this petition in which he admitted that he was not a member of the Bar, and admitted all the other allegations thereof with the exceptions or qualifications which follow.

As to advising clients on infringement of existing patents, respondent stated he did so only on one occasion and that he did so as a part of his work in filing an application for a patent for a client. As to patent license agreements he alleged that he prepared such only in rough and never in finished form.

He denied that he had prepared any other contracts and denied that he had prepared briefs and authorities with points of law relating thereto.

In defense he also asserted, among other things, that he is duly admitted to practice before the Patent Office, having been admitted in 1928, and under the rules and regulations of that office he is authorized to use the nomenclature "Patent Attorney" even though he is not an attorney-at-law in any jurisdiction; the acts performed by him do not constitute the unauthorized practice of law; and that the injunctive relief prayed for would, if granted, deprive him of the ability to earn a living and deprive him of property without due process of law under the Constitution of [fol. 116] Florida and the Fifth and Fourteenth Amendments to the United States Constitution.

The matter has been submitted on the pleadings. The material facts being admitted there is no need for the taking of testimony.

While not raised by either party the first question which we feel necessary for decision is whether this matter is within the original jurisdiction of this Court.

In 1956 the electorate of this state adopted a revised Article V of our state constitution. Section 23 of this new article gives this Court "exclusive jurisdiction over the admission to the practice of law and the discipline of persons admitted."

Quite obviously this matter now before us does not involve either the admission of an applicant to the Bar or the discipline of one already admitted. The question then is whether the authority imposed in Section 23, Article V, also carries with it the power to prevent the practice of law by those who are not admitted to the practice. We think that it must and it does for if it does not the express power to control admissions would be meaningless.

This identical question was raised in a similar case in *West Virginia State Bar* v. *Earley*, W. Va. 1959, 109 S. E. 2d 420. We adopt as ours the words that court spoke in disposing of the question, at 109 S. E. 2d, p. 440, to-wit:

> ". . . It would indeed be an anomaly if the power of the courts to protect the public from the improper or unlawful practice of law were limited to licensed attorneys and did not extend or apply to incompetent and unqualified laymen and lay agencies. Such a limitation of the power of the courts would reduce the legal profession to an unskilled vocation, destroy the usefulness of licensed attorneys, as officers of the courts, and substantially impair and disrupt the orderly and effective administration of justice by the judicial department of the government; and this the law will [fol. 117] not recognize or permit."

The express power contained in our state constitution makes unnecessary any discussion of the inherent power of the courts to regulate the practice of law and those who engage in it. Were it necessary to do so there is abundant authority to support the view that the courts do have such power. *Petition of Florida State Bar Ass'n*, 1938, 134 Fla. 851, 186 So. 280; *Chicago Bar Ass'n* v. *Kellogg*, 1949, 338 Ill. App. 618, 88 N. E. 2d 519; *In re Baker*, 1951, 8 N. J. 321, 85 A. 2d 505; *West Virginia State Bar* v. *Earley*, 109 S. E. 2d 420, supra.

The next question then is whether this Court may enforce its authority in such matters by either or both contempt proceedings and injunction.

The unauthorized practice of law constitutes a contempt of court. *West Virginia State Bar* v. *Earley*, supra; *In re Baker*, supra. See also Cases Noted, 6 Miami Law Quarterly 606.

In *Hargett* v. *Lake*, Kent. App. 1957, 305 S. W. 2d 523, as in this case before us, a proceeding was brought originally in the appellate court seeking to have a person held in contempt and appropriately punished for practicing law without license or right. That court adjudged the person

involved to be in contempt and ruled that " . . . he is permanently enjoined from engaging in the practice of law."

Aside and apart from these decisions which support the view that a court may invoke contempt and injunctive powers to enforce its authority in such matters, this Court has constitutional authority for so doing.

Sec. 4(2), Art. V, Fla. Const., F.S.A. gives this Court the authority to "issue all writs necessary or proper to the complete exercise of its jurisdiction." Having held above that the authority to regulate the practice of law by those not admitted to the Bar is vested in this Court under the cited section of the constitution, it follows that the power to issue writs necessary to enforce its rules [fol. 118] and orders applies to matters affecting the practice of law as much as to any other rule or order within its jurisdiction to enter.

The next question for decision is whether or not the acts committed by the respondent constitute the practice of law in this state. If this is answered in the negative our work is at an end. However if we find such acts to amount to the practice of law then we must determine whether, respondent having been licensed to practice before it by the Patent Office, this state has the power to deny the respondent the right to so practice in this state.

This Court has not previously been called upon to decide whether the activities charged against the respondent, i.e. the work done by a patent attorney, constitute the practice of law if done in this state.

In *Petition of Kearney*, Fla. 1953, 63 So. 2d 630, 631, this Court said that:

> "It follows that those who hold themselves out to practice in *any field or phase of law* must be members of the Florida Bar, amenable to the rules and regulations of Florida Courts. . . ." (Emphasis added.)

The Bar here urges that the practice of patent law is certainly a field or phase of law within the purview of this Court's opinion in the *Kearney* case.

There are however differences between the *Kearney* case and this one which require that we not treat it as dispositive of this case.

The petitioner Kearney was duly admitted to practice before the Supreme Court and the Tax Court of the United States and before the Treasury Department of the United States. He was not a member of The Florida Bar. He sought permission to practice in Florida as "Federal Tax Counsel" with his court appearances to be limited to the [fol. 119] federal courts and the departments above mentioned. This Court, in proceedings originating before it as in this case, ruled that the permission to practice in this state in the manner contemplated was not governed exclusively by the rules of the United States courts and departments; rather, it held that such would constitute the practice of law in this state and Kearney in order to do so would have to become a member of The Florida Bar, subject to the jurisdiction of this Court. In its opinion this Court cited Sec. 2, Integration Rule, supra, stressing that said rule provides that no person shall engage in any way in the practice of law in this state unless he is an active member of The Florida Bar.

In the *Kearney* case this Court obviously started with the premise that the activities which Kearney wished to pursue in this state constituted the practice of law. This Court did not discuss the question other than to state that the American Bar Association and many states hold that practice before the Tax Court and the Treasury Department may constitute the practice of law, citing decisions in support of the statement.

But in this case we cannot start with the premise that the activities of the respondent constitute the practice of law for he puts this question squarely in issue.

While the *Kearney* case may well stand for the proposition that practice before the Tax Court and the Treasury Department "may constitute the practice of law which may be enjoined if attempted by one not admitted to practice" (63 So. 2d at p. 630) it cannot be said to hold that

practice before any or all other federal administrative agencies necessarily constitutes the practice of law.

[fol. 120] The Bar also cites the case of *Chicago Bar Association* v. *Kellogg*, 88 N. E. 2d 519, supra. In that case the court held that the person so charged, without prejudice to his right to advise and assist applicants for patents in the presentation and prosecution of their applications for patents before the United States Patent Office, should be enjoined from the following activities:

1. giving legal advice;

2. preparing, drafting and construing legal documents, contracts, including patent licenses and deeds, assignments and other evidences of transfer of title to or interests in patent and other property;

3. rendering legal opinions, including legal opinions relating to title to, and validity, infringement and enforcement of, patents and trademarks and rights therein and thereto;

4. preparing, drafting and filing pleadings and other legal documents and papers in suits at law and in equity, in courts of record and before administrative tribunals, other than the Patent Office;

5. participating, as an attorney, in legal proceedings;

6. in behalf of persons represented by him, threatening to bring suits against other parties;

7. preparing and serving notice of and asserting attorney's lien; and

8. charging and collecting fees for legal services rendered by him and rendered by him and others.

[fol. 121] Apparently the court was not asked to and did not enjoin the preparation of applications for letters patent and of amendments to such applications. However, it did enjoin the charging of fees for legal services, including those wherein the Patent Office had jurisdiction.

Respondent's argument is that the practice of "patent law" is not the "practice of law." In support thereof he cites several cases which, while not actually in point, do strongly indicate the subject court's opinion to be that such practice is not the practice of law. *Zenith Radio Corp.* v. *Radio Corp. of America*, 121 F.Supp. 792 (D. Del. 1954); Application of Platamura, 1960, 22 Conn.Sup. 213, 166 A. 2d 859; *Public Service Traffic Bureau, Inc.* v. *Haworth Marble Co.*, 1931, 40 O.A. 255, 178 N.E. 703.

While few cases in other jurisdictions can be found relating to the question whether practice before the Patent Office constitutes practice of law, numerous decisions concerning such question as related to other agencies, departments and commissions can be found. There is lack of uniformity therein as to whether such practice is the practice of law. See Annotation 111 A.L.R. 19 (1937), supplemented in 125 A.L.R. 1173 and 151 A.L.R. 781.

The Patent Office, in the sense pertinent here, is an administrative agency, not a court.

Yet it is not the nature of the agency or body before which the acts are done, or even whether they are done before a tribunal of any sort or in the private office of an individual, that determines whether that which is done constitutes the practice of law. The best test, it seems to us, is what is done, not where, for the safest measure is the character of the acts themselves. If they constitute the practice of law the fact that they are done in the private office of the one who performs them or before a non-judicial body in no way changes their character.

Many courts have attempted to set forth a broad definition of the practice of law. Being of the view that such is nigh onto impossible and may injuriously affect the rights [fol. 122] of others not here involved, we will not attempt to do so here. Rather we will do so only to the extent required to settle the issues of this case.

It is generally understood that the performance of services in representing another before the courts is the practice of law. But the practice of law also includes the giving

of legal advice and counsel to others as to their rights and obligations under the law and the preparation of legal instruments, including contracts, by which legal rights are either obtained, secured or given away, although such matters may not then or ever be the subject of proceedings in a court.

We think that in determining whether the giving of advice and counsel and the performance of services in legal matters for compensation constitute the practice of law it is safe to follow the rule that if the giving of such advice and performance of such services affect important rights of a person under the law, and if the reasonable protection of the rights and property of those advised and served requires that the persons giving such advice possess legal skill and a knowledge of the law greater than that possessed by the average citizen, then the giving of such advice and the performance of such services by one for another as a course of conduct constitute the practice of law.

We will use this measure in testing the acts of the respondent.

The first act to be performed by a person representing another who wishes to secure a patent on an alleged invention is to determine whether the device is patentable. As stated in *Marshall* v. *New Inventors Club, Inc.*, 117 N.E.2d 737, supra, at p. 739:

> "Not every alleged patent is patentable. Hence the rendering of an opinion as to patentability requires a knowledge of the patent statutes and of the decisions interpreting them. . . ."

A patent is undoubtedly a property right. It is difficult to see how any valid distinction can be made between [fol. 123] advising one as to whether he does or does not have a cause of action in a court involving his rights and advising one that he does or does not have a patentable device, under the laws and decisions applicable thereto, and the right to protect the invention by obtaining a patent.

The advising of persons as to their rights under the law universally has been held to be the practice of law. We

think that one who holds himself out to the public in this state as qualified to advise as to patentability and does so is engaging in the practice of law. The same is true of the act of advising as to infringement of patent rights. Both require extensive knowledge of the law, statute and case, in a field of the law that is as technical and involved as any known today.

A patent is variously described as a public franchise or as a contract. In all definitions it is apparent that:

> "A patent duly issued amounts to a contract between the inventor and the government, under which the public, through the government, agrees that, in consideration of the inventor's disclosure of his invention and the grant of the right to use it after his patent expires, he shall be protected in his exclusive use during the life of the patent, . . ." 69 C.J.S., Patents, Sec. 5.

> "Patent is a contract by which the government secures to the patentee the exclusive right to vend and use his invention for a few years, in consideration of the fact that he has perfected and described it and has granted its use to the public forever after. The general rules for the interpretation of grants and contracts govern its construction. . . ." *National Hollow Brake-Beam Co.* v. *Interchangeable Brake-Beam Co.*, 106 Fed. 693 (8th Cir. 1901).

As pointed out by the Supreme Court of the United States in *Topliff* v. *Topliff*, 1892, 145 U.S. 156, 12 S.Ct. 825, 36 L.Ed. 658, the terms of those contractual documents which [fol. 124] constitute a patent make it one of the most difficult of all legal instruments to draw with accuracy. In speaking of the matter in that case the Supreme Court of the United States said, at 145 U.S., p. 171:

> ". . . The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to

draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. . . . "

It is thus apparent that the preparation of applications for patents, and amendments thereto, involves the preparation of the terms of an involved contract and proof of the right to have same issued by the government, requiring legal knowledge and skill far in excess of that possessed by the layman. The preparation of such documents is unquestionably the practice of law and the fact that the preparation and procedures are not done in a court but rather before an administrative agency does not change the character of the acts from legal to non-legal.

Not only is the basic question of patentability controlled by law and court decisions but equally important is the fact that interpretations of the rights protected in a patent are made by the courts. Therefore in drafting and preparing the application and amendments he who prepares the documents must have a clear knowledge of the effect of the existing law on the questions involved, else valuable rights of the inventor may be forfeited.

It is also important to note that the application for a patent, the "actions" or objections thereto issued by the [fol. 125] examiner in the Patent Office, the "amendments" or answers filed to the "actions" by the applicant, and the final allowance or rejection by the examiner constitute the basis and subject matter of any appeal to a Board of Appeals of the Patent Office, and thereafter to the Court of Customs and Patent Appeals or to a federal district court, in the same manner that the record made in a trial court is the subject of review by an appellate court. In such a review of a decision of the Patent Office on a patent application the review is limited to the matters presented

in the application and amendments thereto, and if these documents do not adequately reflect and present the applicant's rights, as required by law and the decisions of the courts, valuable legal rights, which if properly presented to the Patent Office might be saved on review, will be lost.

All that is done in the proceedings before the Patent Office must therefore be done with the view that what is done will or may ultimately be interpreted as to meaning and measured as to sufficiency by a court or courts.

All of these considerations buttress our conclusion that the preparation of patent applications and amendments thereto by the respondent for others in a representative capacity does constitute the practice of law. This statement would also apply to the preparation of licensing agreements and other contracts involving patent rights and interests therein.

The remaining question then is whether the respondent, by virtue of his admission to practice before the Patent Office as a Patent Attorney, has the right to do these things in this state without being admitted to The Florida Bar.

We think this question was answered in the negative in the *Kearney* case, 63 So.2d 630, supra. As above noted, in that case we held that anyone who holds himself out to the practice "in any field or phase of law" must be a member of The Florida Bar.

[fol. 126] In other jurisdictions there seems to be a lack of accord on the question as it relates to practice before other administrative agencies of the federal government.

Respondent points out that in *Chicago Bar Association* v. *Kellogg*, 88 N.E.2d 519, supra, the appellate court in reversing the trial court on that issue refused to enjoin the patent attorney from preparing and prosecuting applications for patents, although it did enjoin him from preparing, drafting and construing "legal documents, contracts, including patent licenses and deeds, assignments and other evidences of transfer of title to or interests in patent and other property." 88 N.E.2d at p. 527. The court did not explain why it refused to enjoin the preparation of applications for patents and amendments thereto.

It did not state that it would not enjoin those acts because the respondent there was licensed by the Patent Office. On the contrary the court in its opinion, at 88 N.E.2d, p. 526, stated that:

> "... The issue before us is not what things defendant may do under the authority he claims from his license to appear before the United States Patent Office, but what things, if any, he has done in violation of the laws of the State of Illinois...."

Just prior to making the above statement the court also said, at 88 N.E.2d, p. 526:

> "... The courts of the State of Illinois, and not the United States Patent Office, may determine what constitutes the illegal practice of law in this State...."

It does not appear from the opinion that the court was asked to enjoin the preparation of application for patents and amendments thereto and this may be the reason why the court did not do so. No other reason is indicated in the opinion.

We do not think the opinion in that case supports this respondent's contention that the license to practice before [fol. 127] the Patent Office gives him the right to practice as a patent attorney in this state.

Respondent also cites the cases of *De Pass* v. *B. Harris Wool Co.*, 1940, 346 Mo. 1038, 144 S.W.2d 146, *Auerbacher* v. *Wood*, 1947, 139 N.J.E. 599, 53 A.2d 800; *In re Lyon*, 1938, 301 Mass. 30, 16 N.E.2d 74; and *Noble* v. *Hunt*, 1957, 95 Ga. 804, 99 S.E.2d 345. Each of these cases in some way supports the view that where a federal court or agency permits a layman to practice before it, a state may not prevent a layman who is licensed to practice before that court or board from such practice in the state even though such actions constitute the practice of law and practice of law by a layman is contrary to the policy of the state.

While we agree that each of the federal courts and each of those federal agencies which are authorized by Congress to do so may determine who shall be permitted to practice

before them, we do not agree that such authority in any way gives those bodies the authority also to determine that those licensed by it have the right to practice law, in the particular field involved, within the borders of this state.

It may well be that this state may not prohibit any person from appearing and practicing law before a federal court or agency in this state, if he be licensed by the federal court or agency, even though such person not be a member of the Bar of this state. But appearing before such bodies is an entirely different thing from a person holding himself out in this state as qualified to practice law before such federal bodies, maintaining an office in this state for that practice, and doing in this state the many things that are necessary to be done preparatory to the actual appearance before such bodies.

For example, if a United States Court of Appeals conducts sessions in this state attorneys from other states, not licensed to practice in this state, could not be prohibited from arguing before that court in this state, but they would not be permitted to establish an office and hold themselves out in this state as qualified to practice [fol. 128] before the federal court unless they were first admitted to the Bar of this state. The *Kearney* case, 63 So.2d 630, supra, settled this point directly.

If we were to hold otherwise any person licensed to practice before the United States Supreme Court or any other federal court could establish an office and hold himself out in this state as being qualified to represent Florida citizens before those courts without this state having any control over their right to so hold themselves out, or any control over their actions.

As a further example, if the federal district courts in this state were to license non-lawyers to practice before them, these non-lawyers, under the rule contended for by respondent, would have the right to establish an office in this state and to hold themselves out to the citizens of this state as qualified to practice law before such courts and this state would be powerless to protect its citizens in the matter.

Fortunately no such dispute has yet arisen between the states and the federal courts and it is hoped that it never will. Generally speaking the federal courts permit only duly admitted lawyers to practice before them and the matter of determining whether persons shall be admitted to the Bar has been left to the states. It appears that it is only in the federal quasi-judicial and administrative agencies, such as the Patent Office, that the non-lawyer is licensed to practice.

As above stated, we have no argument with the power of such agencies to determine who shall practice before them, but we do not agree that their licensing of a non-lawyer is in anywise to be taken as proof that the work done before them is not the practice of law or that one licensed by them has the right by virtue of said license to hold himself out as qualified to do those things in this state.

It is generally held that a state acting under its police power has the right to define the practice of law and to [fol. 129] determine who is qualified to practice within its borders. *Chicago Bar Association* v. *Kellogg*, 88 N.E.2d 519, supra; *Petition of Florida State Bar Association*, 186 So. 280, 285, supra; *Clark* v. *Austin*, 1937, 340 Mo. 467, 101 S.W.2d 977; *Richmond Association of Credit Men, Inc.* v. *Bar Association of City of Richmond*, 1937, 167 Va. 327, 189 S.E. 153.

We know of no provision in the Federal Constitution, or statutes for that matter, that gives to any federal body the power to determine who may practice law in the several states, or to define the practice of law within the states, and the respondent has cited us none. We do not think that the power to determine who may practice before it gives any such body the implied power to make either determination for this state.

We therefore hold that the license to practice before the Patent Office held by respondent does not give him the right to do in this state those things above listed.

The reason for prohibiting the practice of law by those who have not been examined and found qualified to practice is frequently misunderstood. It is not done to aid or pro-

tect the members of the legal profession either in creating or maintaining a monopoly or closed shop. It is done to protect the public from being advised and represented in legal matters by unqualified persons over whom the judicial department can exercise little, if any, control in the matter of infractions of the code of conduct which, in the public interest, lawyers are bound to observe.

It cannot be denied that the public suffers, as does both the public image of the legal profession and our judicial system, when those not qualified to do so are permitted to hold themselves out as qualified to practice law and as worthy of the trust and confidence of those who have legal problems the solution of which require trained advice and counsel.

If the truth be known the unauthorized practice of law by those not qualified and admitted actually creates work for the legal profession because of the errors and mistakes [fol. 130] of those who for others illegally perform legal work they are not competent to perform. In this the members of the legal profession gain, but the unfortunate members of the public who were ill-advised lose, in some instances quite badly.

It is the effort to reduce this loss by the members of the public that primarily justifies the control of admissions to the practice of law, discipline of those who are admitted, and the prohibition of the practice to those who have not proved their qualifications and been admitted. As incidents of this system the administration of justice is aided and the public image of the legal profession is enhanced.

Here it should be said that no one who evidences the reasonable standards of education, training, experience, good morals and character required by the rules of this Court and who can pass the bar examination, which is given twice yearly, is denied the privilege of practicing law in this state. There is no quota or limit to the number who may be admitted.

In fairness to the respondent in this cause we make clear that nothing we have said in this opinion is intended to indicate that he is not in fact competent to perform those services which he has rendered or that the affairs of any citizen of this state have suffered at his hands.

It may be that he is fully competent to practice law, that he has the educational and other qualifications required of an applicant for admission to the Bar of this state, and that he is well able to pass the bar examination, but until he has done so we have no way of assuring the public that he is qualified to practice law in this state.

Respondent argues that if we grant the injunction prayed for by the Bar we would deprive him of the ability to earn a living and deprive him of property without due process of law contrary to the guarantees of the Florida and United States Constitutions.

The issuance of an injunction by this Court will deprive respondent of the right to earn a living in the practice of [fol. 131] law in this state, but it will take nothing from him to which he has any right, for he does not now have the right to practice law in Florida. Nor will it in any way affect his right to practice before the Patent Office in Washington, D.C.

The right to practice law is not a privilege or immunity of a citizen of the United States within the meaning of the Fourteenth Amendment to the Constitution of the United States. *West Virginia State Bar* v. *Earley*, 109 S.E.2d 420, supra, *Ginsburg* v. *Kovrak*, 1958, 392 Pa. 143, 139 A.2d 889, appeal dismissed 358 U.S. 52, 79 S.Ct. 95, 3 L.Ed.2d 46. See also *Petition of Florida State Bar Association*, 186 So. 280, supra.

Our conclusion, then, is that the respondent, until and unless he becomes a member of the Bar of this state, should be and is permanently enjoined from the following activities in this state:

1. using the term "patent attorney" or holding himself out to be an attorney at law in this state in any field or phase of the law (we recognize that the respondent according to the record before us has already voluntarily ceased the use of the word "attorney");

2. rendering legal opinions, including opinions as to patentability or infringement on patent rights;

3. preparing, drafting and construing legal documents;

4. holding himself out, in this state, as qualified to prepare and prosecute applications for letters patent, and amendments thereto;

5. preparation and prosecution of applications for letters patent, and amendments thereto, in this state; and

6. otherwise engaging in the practice of law.

This injunction cannot and shall not in anywise be construed to affect any rights which the respondent has to practice before the Patent Office when done outside this state.

[fol. 132] It appearing to us that the respondent has cooperated in seeking a determination of his right to do the things charged against him and has not willfully violated any order or rule of this Court which clearly settled the issues involved here, we do not feel that we should now hold him in contempt of this Court. We have no reason to believe that he will not obey the injunction contained herein. If he does, then an order in contempt will be appropriate.

It is so ordered.

Roberts, C.J., Thomas, Drew and Thornal, JJ., concur.

[fol. 133]

IN THE SUPREME COURT OF FLORIDA

January Term, A. D. 1962

[Title omitted]

STAY ORDER—May 16, 1962

In consideration of the motion of attorneys for respondent in the above entitled cause it is ordered that the execution and enforcement of the judgment of the Supreme Court of Florida entered in said cause on April 4, 1962, respondent's petition for rehearing denied May 15, 1962, be and is hereby stayed for ninety (90) days from this date to enable the petitioner to have a reasonable time in which to apply for and to obtain, if he can, a review of said cause by the Supreme Court of the United States, and if such proceeding is perfected and filed in the Supreme Court of the United States within said ninety (90) day period that said judgment be further stayed until said proceeding is disposed of by the Supreme Court of the United States or until the further order of this Court. This order is subject to cancellation at any time if said respondent fails to prosecute such review with reasonable dispatch.

[fol. 134] Clerk's Certificate (omitted in printing).

[fol. 135]

SUPREME COURT OF THE UNITED STATES

ORDER ALLOWING CERTIORARI—October 22, 1962

The petition herein for a writ of certiorari to the Supreme Court of the State of Florida is granted, and the case is transferred to the summary calendar.

And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.